

### **REMARKS**

This communication responds to the Office Action mailed August 23, 2006.

In the present communication, applicant has amended claims 5, 20, and 39. No new subject matter has been added to the claims.

Support for the amendments to the claims can be found in the specification at least at page 5, line 24 to page 6, line 12.

Claims 1, 4, 13, 14, 16, 19, 27-35, and 43-44 were previously canceled. Therefore, claims 2, 3, 5-12, 15, 17, 18, 20-26 and 36-42 are pending.

The §103(a) rejection of the claims is respectfully traversed in view of the above amendments and the below discussion.

The amendment of the claims is to help more distinctly claim the invention and is not in acquiescence to any pending rejection. Applicant reserves the right to present the original claims in this or a continuation application. No prejudice shall be inferred by the amendments.

#### **Examiner Interview:**

The Examiner interview conducted between Bridget Hayden and Examiner Tran is appreciated. The discussion focused around clarifying the distinguishing features of the claims related to the suspension and how it is deposited over IQF fruit in a generally discrete layer. No agreement was reached.

#### **Rejection of Claims 2 through 3, 5 through 12, 15, 17 through 18, 20 through 26 and 36 through 42 under 35 U.S.C. § 103(a)**

Claims 2 through 3, 5 through 12, 15, 17, 17 through 18, 20 through 26 and 36 through 42 were rejected under 35 U.S.C. 103(a) over the Office Action's assertion of admitted prior art in view of U.S. Patent No. 6,562,385 Neumann (hereinafter "Neumann") in view of U.S. Patent No. 4,623,542 Wallin et al. (hereinafter "Wallin").

The § 103(a) rejection is respectfully traversed for at least the following reasons, which are in addition to the reasons for traverse filed in the Response dated June 22, 2006.

The present invention discloses a pie filled with frozen fruit and teaches a method for manufacturing a pie filled with frozen fruit that includes the steps of mixing ingredients to create

pie dough; forming a portion of said pie dough into a pie shell; adding individually quickly frozen ("IQF") fruit into said pie shell; depositing a suspension compound over said IQF fruit in said pie shell wherein in an initial state, said suspension compound generally forms a discrete layer, and wherein said suspension compound comprises: a range of about 38% to about 88% liquid sweetener; a range of about 5% to about 55% dry sweetener; a range of about 4% to about 15% food starch; and a range of about 0.01% to about 5% food gum; and applying a top sheet of pie dough over said suspension layer, IQF fruit and pie shell to complete the frozen fruit filled pie product assembly, wherein said IQF fruit remains frozen throughout the manufacturing process; transporting the frozen fruit filled pie product in an initial frozen state; and baking the frozen fruit filled pie product, wherein the suspension layer in the initial frozen state exhibits a reduction of viscosity when exposed to heat causing the suspension layer to disperse around the IQF fruit, and wherein the suspension exhibits an increase of viscosity when exposed to temperatures above 120° Fahrenheit, such that in a baked state the suspension layer and the IQF fruit migrate together to form an IQF fruit suspension.

The present invention is also directed toward a method for suspending frozen fruit in a pie filled with frozen fruit having ingredients of various specific gravities which includes the following steps: mixing a first set of ingredients to form a suspension, said suspension comprised of: a range of about 38% to about 88% liquid sweetener; a range of about 5% to about 55% dry sweetener; a range of about 4% to about 15% food starch; and a range of about 0.01% to about 5.0% food gum; mixing a second set of ingredients to create pie dough; forming a portion of said pie dough into a pie shell; adding individually quickly frozen ("IQF") fruit into said pie shell; adding said suspension over said IQF fruit in said pie shell, wherein in an initial state, said suspension generally forms a discrete layer; and applying a top sheet of pie dough over said suspension layer, IQF fruit and pie shell to complete the frozen fruit filled pie product assembly, wherein said IQF fruit remains frozen throughout the manufacturing process; transporting the frozen fruit filled pie product in an initial frozen state; and baking the frozen fruit filled pie product, wherein the suspension layer in the initial frozen state exhibits a reduction of viscosity when exposed to heat allowing the suspension layer to disperse among the IQF fruit, and wherein the suspension exhibits an increase of viscosity when exposed to temperatures above 120° Fahrenheit, such that in a baked state the suspension layer and the IQF fruit migrate together to form an IQF fruit suspension.

As can be seen, the method for forming a suspension also includes the unique features described above in which the suspension, in an initial state, generally forms a discrete layer, and in a baked state, the suspension and the IQF fruit migrate together to form an IQF fruit suspension. This is also an advantage over the prior art because, as claimed, the liquid suspension is deposited over the IQF fruit once the IQF fruit has been added to the pie shell, rather than being mixed together with the IQF and deposited as a mixture onto the pie shell.

The above-mentioned benefit provided by the present invention provides the consumer with a finished pie having characteristics desirable to the customer. For example, when dry ingredients are added to the IQF fruit, the finished product does not result in a glossy suspension, a feature attractive to the consumer. In addition, use of the above methods reduces production times and energy costs compared to typical methods. For example, because the IQF fruit and suspension are not mixed together during production, the time and energy typically required for such a mixing step is eliminated. Thus, profitability of producing pie products is increased.

Now the references of record are considered.

In contrast to the present invention, Neumann discloses a food product with flavoring and a method for producing the same.

Wallin, in contrast to the present invention, discloses a high stability, high flavor, breakfast pastry and method for preparing the same.

Neumann and Wallin, alone or in combination, fail to teach, suggest, or provide any motivation or expectation of success to one of ordinary skill in the art, the present invention.

In particular, the present invention includes a suspension for a frozen fruit pie, where the suspension, in an initial state, generally forms a discrete layer.

In contrast, Neumann discloses adding flavoring to pre-baked cereal-based products,

a flavoring is added to the indentations or cavities in the form of a topping and/or incorporated into inclusions that are imbedded in the pre-baked cereal-based product. Any flavoring suitable for use with the pre-baked cereal-based product may be used. Such flavorings include authentic maple syrup, molasses, honey, as well as fruit.

Neumann col. 3, lines 41-46. According to Neumann, when fruit is incorporated into the flavored pre-baked cereal-based products, the fruit flavoring is incorporated as a part of the flavoring. Neumann states:

a preferred method of making the flavoring toppings comprise uniformly blending the previously enumerated ingredients and boiling the ingredients. The boiled flavoring is then cooled from about 90 °F to 120 °F. The natural and/or artificial flavor components are added, thoroughly mixed, and the flavoring is then applied to an exteriormost surface of the food product 100.

Neumann col. 6, line 66 to col. 7, line 6. Thus, in Neumann, when fruit is added to the flavor topping, the components are thoroughly mixed. Therefore, Neumann fails to provide any motivation or expectation of success to one of ordinary skill in the art to deposit a suspension, in an initial state, that generally forms a discrete layer.

Wallin, in contrast to the invention, discloses a pastry filling having a controlled pH and viscosity. However, Wallin does not teach or suggest how the filling is prepared in order to result in a filling having such characteristics. Therefore, Wallin fails to provide any motivation or expectation of success to one of ordinary skill in the art to deposit a suspension, in an initial state, that generally forms a discrete layer.

Neumann and Wallin, alone or in combination, fail to teach, suggest, or provide any motivation or expectation of success to one of ordinary skill in the art, the present invention's suspension, in an initial state, that generally forms a discrete layer.

Moreover, the suspension of the present invention, in a baked state, migrates together with the IOF fruit to form an IOF fruit suspension.

Neumann discloses that the flavoring components are thoroughly mixed at Neumann col. 6, line 66 to col. 7, line 6. Thus when the flavoring is deposited on the pre-baked cereal-based products, the mixture is already a complete fruit and flavoring suspension, and the components do not migrate together upon baking. Therefore, Neumann fails to provide any motivation or expectation of success to one of ordinary skill in the art to provide a suspension which, in a baked state, migrates together with IOF fruit to form an IOF fruit suspension.

Wallin, in contrast to the invention, discloses a pastry filling having a controlled pH and viscosity. However, Wallin does not teach or suggest how the filling is prepared in order to result in a filling having such characteristics. Therefore, Wallin fails to provide any motivation

or expectation of success to one of ordinary skill in the art to provide a suspension which, in a baked state, migrates together with IOF fruit to form an IOF fruit suspension.

Neumann and Wallin, alone or in combination, fail to teach, suggest, or provide any motivation or expectation of success to one of ordinary skill in the art, the present invention's suspension which, in a baked state, migrates together with IOF fruit to form an IOF fruit suspension.

It is well settled that it is not proper to selectively extract individual elements from the different contexts of different references and then combine those selectively extracted elements to arrive at a claimed combination. Rather in considering the elements within the references, the references must be considered as a whole, it being impermissible to pick and choose from a reference only so much of it as will support a given position. *In re Wesslau*, 353, F.2d 238, 147 USPQ 391 (CCPA 1965); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). There is a rigorous requirement that there must be some motivation, suggestion or teaching of the desirability for selecting the elements and combining those elements in the specific combination of the invention, and the motivation, suggestion or teaching must be disclosed in the reference(s). *In re Kotzab*, 217 F.3d 1365, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000); *In re Oetiker*, 977 F.2d 14343, 24 USPQ2d 1443 (Fed. Cir. 1992). In the absence of such motivation, suggestion or teaching, it is immaterial that some, or even all, of the elements in a specific combination of an invention are known in the art. As clearly stated in *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998):

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713F2d 693, 698,218 U.S.P.Q. (BNA) 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F2d 1573, 1579-80, 219 U.S.P.Q. (BNA) 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the

prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2D (BNA) 1551,1554 (Fed. Cir. 1996).

and:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In the present case, the examiner believes that the recitations of the claims are taught by a combination of the cited references. However, “there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention.” *Smiths Ind. Medical Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d 1347 (Fed. Cir. 1999) (*referencing Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556 (Fed. Cir. 1985)). Accordingly, even if depositing a discrete suspension layer over IQF fruit is known in the art, the claims of the present invention are not obvious. This is because, as discussed above, neither Neumann nor Wallin provide any motivation or expectation of success to one of ordinary skill in the art to modify Neumann or Wallin to deposit a suspension over IQF fruit where the suspension, in an initial state, generally forms a discrete layer.

Moreover, even if a suspension is known to migrate together with IQF fruit to form an IQF fruit suspension by one of skill in the art, the claims of the present invention are not obvious. This is because, as also discussed above, neither Neumann nor Wallin provide any motivation or expectation of success to one of ordinary skill in the art to modify Neumann or Wallin to employ a suspension which, in a baked state, migrates together with IQF fruit to form an IQF fruit suspension.

Furthermore, the Wallin and Neumann references cited in the August 23, 2006 Office Action do not provide motivation, suggestion or teaching, and no showing has been made

otherwise identifying in the references such a motivation, suggestion or teaching, for selecting elements from the cited references to render obvious the method recited in the claims, and the invention cannot be used as a blueprint for identifying a suggestion or motivation. As stated in *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d (BNA) 1614 (Fed. Cir. 1999):

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2D (BNA) 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USP.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2D (BNA) 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 U.S.P.Q. (BNA) 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). See also *Graham*, 383 U.S. at 18, 148 U.S.P.Q. (BNA) at 467 (“strict observance” of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. (BNA) 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”). In this case the Board fell into the hindsight trap.

Nonetheless, the Examiner uses the present invention as a blueprint for piecing together Neumann and Wallin because neither Neumann nor Wallin teaches or suggests a method for manufacturing a pie filled with frozen fruit in which the fruit remains frozen throughout the

manufacturing process as recited by the independent claims. The Examiner states “[a]s to maintaining the IQF fruit in frozen state throughout processing and transporting in frozen state[sic], it would have been obvious to one skilled in the art to so to[sic] prevent the fruit from thawing. Thawing of the fruit will give off water which will cause sogginess of the dough crust and thus interfere with the quality of the product. It would have been within the routine experimentation of one skilled in the art to determine the most optimum processing parameters to produce the highest quality product.” However, the Examiner does not provide any support from the cited Neumann or Wallin references that indicates that thawing fruit causes sogginess of the dough crust, and further does not provide any motivation or expectation of success to one of ordinary skill in the art to experiment in order to maintain the IQF fruit in a frozen state. Instead, Neumann discloses that fruit is added to the flavoring when it is at a temperature of 90-120 °F. Neumann col. 6, line 66 to col. 7, line 6. Thus, any fruit added, if it were initially frozen, which there is no indication of the fruit being initially frozen, would begin to thaw once added to the flavoring. Accordingly, Neumann does not provide any motivation or expectation of success to one of ordinary skill in the art to experiment with the fruit flavoring in order to maintain the fruit of the fruit flavoring in the frozen state throughout the manufacturing process. Wallin does not disclose conditions in which the pastry filling is prepared. Therefore, Wallin does not provide any motivation or expectation of success to one of ordinary skill in the art to experiment with the pastry filling, or to experiment with frozen fruit and pastry filling.

Accordingly, one of ordinary skill in the art would not look to Neumann or Wallin when attempting to develop a method for manufacturing a pie filled with frozen fruit in which the fruit remains frozen throughout the manufacturing process. Therefore, the Examiner has used impermissible hindsight in the Office Action of August 23, 2006, has failed to establish a *prima facie* case of obviousness, and thus the combination of Neumann and Wallin is improper.

In view of the above, even if the asserted Neumann/Wallin combination is proper, which it is not, the cited references do not render independent claim 5, 20, and 39 obvious. The combination would not teach a pie filled with frozen fruit in which the fruit remains frozen throughout the manufacturing process that includes a suspension, that in an initial state, generally forms a discrete layer and that in a baked state, migrates together with IQF fruit to form an IQF fruit suspension.



The remaining dependent claims, claims 2, 3, 6-12, 15, 17, 18, 21-26, 36-38 and 40-42, depend directly or indirectly from claims 5, 20, and 39 and are allowable for at least the same reasons, further in view of their additional recitations.

It is believed that all of the issues raised in the Office Action have been addressed herein. Should the Examiner maintain any of the rejections of any of the pending claims, it is respectfully requested that it be pointed out with particularity how the cited reference(s) meet each and every term of each claim with respect to which rejection is maintained, and if the rejection is based on obviousness, identification of the specific motivation, suggestion or teaching in the art for combining elements in the specific combination of the invention.

For the above reasons, reconsideration and withdrawal of the § 103 rejection is requested.

**CONCLUSION**

This application now stands in allowable form, and reconsideration and allowance are respectfully requested.

No fee is deemed necessary. The commissioner is authorized to charge any additional fees, including extension fees or other relief that may be required, or credit any overpayment to Deposit Account No. 04-1420.

Respectfully submitted,

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Date: November 13, 2006

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